D.   Remarks

In response to the Office Action mailed August 14, 2003, the Applicants respectfully request reconsideration of the application in view of the amendments above and the following remarks.

Claims 1-36, 40, 41, 43-49, 52-90, 94, 95, 97-103, and 106-111 are currently pending.

The Applicants amended claim 35, 41, and 46 to correct typographical errors. The Applicants also amended the specification in response to an objection by inserting the language from claims 1-3 as originally filed into the summary-of-the-invention portion of the specification.

Objection to the Specification

Page 3 of the August 14, 2003 Office Action states the following:

> The specification is objected to as failing to provide antecedent basis for the claimed subject matter.... Claims 1-3 (both as originally filed and currently amended) recite the step of "storing said data in an indexed and normalized form in a knowledge base adapted for structured query and retrieval"; however, description of this limitation is lacking in the specification.

In response, the Applicants have inserted the language from claims 1-3 as originally filed into the summary of the invention portion of the specification. The Applicants note that the specification on page 3 between lines 18-20 describes that one can "store such information in a knowledge base for later query and retrieval." Moreover, the knowledge base structure is described, among other places, between page 36, line 32 and page 38, line 36. In addition, the claims as originally filed form part of the application. Thus, no new matter has been added.

Rejection of claims 1-3 under 35 U.S.C. § 112, first paragraph

The Office Action rejected claim 1-3 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.

The Office Action states that the following":

> The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
>
> Independent claims 1-3 have recently been amended to recite the limitation, "said knowledge base enabling selection of an in process analysis for modification by a user." However, there is no disclosure of this limitation in the specification, as originally filed.... It is respectfully requested that Examiner [sic] either point out where said limitation is disclosed in the specification, as originally filed, or delete said limitation from the claims.

The Applicant notes that the specification, as originally filed, on page 23, between lines 9 and 14, states the following:

> Each decision analysis screen sequence is stored in a unique file to facilitate later indexing, searching, and retrieval from the knowledge base. A previous or in process decision analysis can be selected for modification by the user. [Emphasis added.]

In addition, the specification, as originally filed, describes the operation and structure of the knowledge base throughout the specification including between page 36, line 32 and page 38, line 36. Thus, the Applicants assert that the claimed subject matter was described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Given the above, the Applicants respectfully request withdrawal of this rejection.

Rejection of claims 1-36, 40, 41, 43-49, 52-90, 94, 95, 97-103, and 106-111 under 35 USC 103(a)

Claims 1-36, 40, 41, 43-49, 52-90, 94, 95, 97-103, and 106-111 stand rejected under 35 USC 103(a) as unpatentable over Decision Focus® Software, as disclosed in the following documents submitted by the Applicants:

"Decision Focus® Software User's Guide (Version 1.0)," copyright 1995;

"Decision Focus® Software Network Version 1.0 User's Guide," copyright 1995;

Print-outs of On-Screen Worksheets from "Decision Focus® Software; and

Screenshots (FIGS. 1-24) from "Decision Focus® Software (Version 1.0)

in view of Lee ("Justifying Database Normalization: A Cost/Benefit Model"). The Decision Focus (DF) documents list directly above are hereinafter referred to as the "DF documents." Reconsideration and withdrawal of the obviousness rejection is deemed in order and requested.

Description of the Invention

Embodiments of the invention provide a computer software application, graphical user interface (GUI), and method for entering information concerning a complex business situation, refining such information in a stepwise manner through such an interface, generating a list of effective actions for addressing such a business situation, and storing such information in a knowledge base adapted for future query and reporting use for such complex business situations. A set or sequence of process screen structures allows entry of specific aspects of such a situation to generate such an action list. Such process screen sequences provide a systematic method to

gather and organize information effectively in order to resolve a complex situation, and to store such information in a knowledge base for later query and retrieval for the same or similar situations, thereby preserving enterprisewide knowledge and expertise. An action tracker interface is also provided which provides task management and monitoring of the various actions determined by the process screen sequences. The user has the ability to access the process screens in a non—linear mode and can toggle between interview and worksheet modes.

Claim 1

Amended claim 1 provides a method of gathering, processing, storing, and displaying information concerning a complex business situation. The method includes providing a graphical user interface for entering data concerning said complex business situation; refining the data in a predetermined, stepwise manner through user interaction with the graphical user interface; generating, through the stepwise manner and the graphical user interface, a list of effective actions for addressing the complex business situation; and *storing the data in an indexed and normalized form in a knowledge base adapted for structured query and retrieval in performing the steps of refining and generating*. The knowledge base enables *selection of an in process analysis for modification by a user*. Claims 2 and 3 contain similar limitations.

Response to rejection of claims 1-3

Contrary to the assertion in the August 14, 2003 Office Action that claim 1 is obvious over the DF documents in view of the Lee document, claim 1 recites elements/limitations that are completely absent from the DF documents and the Lee document, alone or in combination.

The DF documents

In particular, the DF documents do not disclose "*storing the data in an indexed and normalized form in a knowledge base adapted for structured query and retrieval in performing the steps of refining and generating* [emphasis added]," as claimed in currently pending claim 1. The knowledge base is shown as element 42 in FIG. 2 of the present application. Embodiments of the structure of the knowledge base are illustrated in FIGS. 38-42 of the present application.

The only statements made in the August 14, 2003 Office Action directly addressing the obviousness rejection of claim 1 are located on page 18 and state in relevant part:

> Claims 1-3 recite limitations already addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 above; therefore the same rejection applies.

Claims 1-3 contain elements/limitations, including the element(s)/limitation(s) underlined and italicized above, that are unique to claims 1-3. Thus, Applicants respectfully assert that claims 1-3 recite limitations that were not addressed by the rejection of claims 4-36, 40, 41, 43-

49, and 52-57. Moreover, portions of both the June 3, 2002 Office action and the August 14,

2003 Office Actions appear to acknowledge that the DF documents do not disclose the

element(s)/limitation(s) underlined and italicized above.

More specifically, page 11 of the June 3, 2002 Office Action issued in this case states:

> EDI [Decision Focus® Software User's Guide (Version 1.0)] does not expressly teach storing said data in an indexed and normalized form in a knowledge base adapted for structured query and retrieval in performing said steps of refining and generating.

Furthermore, page 11 of the August 14, 2003 Office Action in this case states:

> Broadly speaking, a "knowledge base" merely refers to a collection of knowledge, i.e., data; therefore, the collection of these worksheet files serves as a "knowledge base." Decision Focus® Software does not expressly teach that these centrally stored worksheet files are linked to one another in a large database (which is what would be suggested by placing the information found in such files in a "knowledge base"). [Emphasis added.]

Thus, the two portions of the June 3, 2002 Office Action and the August 14, 2003 Office

Action quoted immediately above appear to acknowledge that the DF documents do not disclose

the element(s)/limitation(s) italicized and underlined above.

In addition, the DF documents do not teach "*selection of an in process analysis for*

modification by a user," as claimed in currently pending claim 1.

As noted above, the only statements made in the August 14, 2003 Office Action directly

addressing the obviousness rejection of claim 1 are located on page 18 and state:

> Claims 1-3 recite limitations already addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 above; therefore the same rejection applies.
> Furthermore, regarding the limitation "said knowledge base enabling selection of an in process analysis for modification by a user" (as recited in claims 1-3), the networked version of Decision Focus® Software allows a user to access data currently being used by another person. The user then makes a copy of the desired file so that he/she does not overwrite someone else's work, thereby implying that the user can modify the data in the copied file ("Decision Focus® Software Network Version 1.0 User's Guide": Page 11). [Emphasis added.]

In contrast to the above-quoted characterization of page 11 of DF Network (DECISION

FOCUS Software, Network Version 1.0, User's Guide) and with reference to that same page 11,

if a user attempts to open a worksheet file that is already opened by someone else running

Decision Focus, "the software informs the user that the file is already in use". Although a user

appears to be able to make a copy of the file, *as stated on page 11 of DF Network, "if you*

subsequently attempt to save that copy, you are not allowed to save the copy to the same name

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as the original file name." Thus, the DF documents do not teach that the knowledge base enables selection of an **in process** analysis for modification by the user, as claimed in currently pending claim 1, *because a user of DF Network cannot modify an in process analysis.* The ability to modify an in process analysis is advantageous, among other reasons, for collaborative analysis, i.e., an analysis by more than one individual.

The Lee document

Furthermore, the Lee document does not disclose the element(s)/limitation(s) italicized and underlined above, i.e., 1) *storing the data in an indexed and normalized form in a knowledge base adapted for structured query and retrieval in performing the steps of refining and generating;* and/or 2*) selection of an in process analysis for modification by a user,* as claimed in currently pending claim 1. As noted above, the only statements made in the August 14, 2003 Office Action directly addressing the obviousness rejection of claim 1 are located on page 18 and state in relevant part:

> Claims 1-3 recite limitations already addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 above; therefore the same rejection applies.

Claims 1-3 contain elements/limitations, including the element(s)/limitation(s) underlined and italicized above, that are unique to claims 1-3. Thus, Applicants respectfully assert that claims 1-3 recite limitations that were not addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57.

Furthermore, to the extent that the August 14, 2003 Office Action discusses the Lee document at all, the Office Action appears to discuss the Lee document only briefly on pages 12 and 13. On page 12, the August 14, 2003 Office Action states in relevant part:

> Lee discusses the benefits ("reduced anomalies, storage requirements, and transaction response time") of utilizing normalized databases "in information systems development processes to group data into well-refined structures."

The August 14, 2003 Office Action appears to be quoting a portion of the abstract of the Lee document. The complete abstract indicates that there are costs associated with normalization. More specifically, the complete abstract states the following:

> Proposes a **cost/benefit model** coupled with a decision tree for determining normal forms, which are used in information systems development processes to group data into well-refined structures. The three primary variables that impact the benefits **and costs of normalization** (reduced anomalies, storage requirements, and transaction response times) **are addressed**. [Emphasis added.]

In any event, the Lee abstract in particular and the Lee document in general do not teach:
1) *storing the data in an indexed and normalized form in a knowledge base adapted for*
structured query and retrieval in performing the steps of refining and generating; and/or 2)
selection of an in process analysis for modification by a user, as claimed in currently pending
claim 1.

The DF and Lee documents

The August 14, 2003 Office Action does not and can not point to a teaching in the DF
and/or Lee documents of the above-referenced element(s)/limitation(s). If the Examiner repeats
this rejection, the Applicant respectfully requests that the Examiner specify where in either the
DF documents or the Lee document such element(s)/limitation(s) is/are taught.

Thus, even if one were to combine Lee and the DF documents as suggested one would
not arrive at the claimed invention.

Furthermore, there is no motivation or suggestion in the cited documents to make the
combination indicated in the Office Action. Obviousness cannot be established by combining
the teachings of the cited documents to produce the claimed invention, absent some teaching
suggestion or incentive supporting the combination. See In re Geiger, 815 F.2d 686, 2 USPQ 2d
1276, 1278 (Fed. Cir. 1987).

It is impermissible for the Examiner to use the claimed invention as a "template" to piece
together the teachings of the prior art references so as to render the claimed invention obvious.
In re Gorman, 933 F.2d 982, 987 (Fed. Cir. 1991). Under no condition can the Examiner
combine the teachings of references, unless those references include some teaching or suggestion
supporting the combination. In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (quoting ACS
Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 (Fed. Cir. 1984))

The Examiner is not allowed to use hindsight to pick and choose among pieces of prior
art references so as to reconstruct the claimed invention. In re Fritch, 972 F.2d at 1266. As the
Federal Circuit has observed on more than one occasion, "[t]o imbue one of ordinary skill in the
art with knowledge of the invention in suit, when no prior art reference or references of record
convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight
syndrome wherein that which only the inventor taught is used against its teacher." In re Fine, 837
F.2d 1071, 1075 (Fed. Cir. 1988) (quoting W.L. Gore & Assoc. v. Garlock. Inc., 721 F.2d 1540,
1553 (Fed. Cir. 1983)). See also Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 313, 227
USPQ 2d. 1923, (Fed. Cir. 1985) Additionally, it is improper to focus on obviousness of

substitutions, instead of on an invention as a whole. Gillette Co. v. S.C. Johnson & Son, Inc. 16 USPQ 2d. 1923 (Fed. Cir. 1990)

It is the invention as a whole which must be evaluated. "...the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's method and device." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ 2d. 1321 (Fed. Cir. 1990)

As noted above, the only statements made in the August 14, 2003 Office Action directly addressing the obviousness rejection of claim 1 are located on page 18 and state in relevant part:

> Claims 1-3 recite limitations already addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 above; therefore the same rejection applies.

Claims 1-3 contain elements/limitations, including the element(s)/limitation(s) underlined and italicized above, that are unique to claims 1-3. Thus, Applicants respectfully assert that claims 1-3 recite limitations that were not addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 and, moreover, that *the August 14, 2003 Office Action does not point to where in the cited documents one can find a motivation or suggestion to combine the cited documents to achieve the invention claimed in currently pending claim 1*.

Furthermore, *to the extent that the August 14, 2003 Office Action discusses the Lee document at all*, the Office Action appears to discuss the Lee document only briefly on pages 12 and 13. On page 12, *the August 14, 2003 Office Action states* in relevant part:

> Lee discusses the benefits ("reduced anomalies, storage requirements, and transaction response time") of utilizing normalized databases "in information systems development processes to group data into well-refined structures." Therefore, the Examiner asserts that *it would have been obvious* to one of ordinary skill in the art at the time of Applicant's invention *to centrally store the data from Decision Focus® Software collective worksheet files in a "knowledge base"* (in the stricter sense of a "knowledge base" as a database per se of information), *such as a normalized database, in order to facilitate access to all of the collected worksheet files by various networked users* through keyword searches *in order to provide quick access to data in a manner that reduces anomalies, minimizes storage requirements, and improves transaction response time (as taught by Lee)*. [Emphasis added.]

In contrast to the characterization of the teaching of Lee provided in this quote from the August 14, 2003 Office Action, Lee teaches away from making the suggested combination. The Lee document describes design choices that one makes when designing a relational database and

describes the efforts that one undertakes to create and maintain a relational database model. For

example, the second full paragraph of page 2 of the Lee document states in relevant part:

> [the database administrator] is often responsible for backing up and
> restoring the database when it becomes corrupted due to equipment failure,
> power loss, or program errors.

The top of page 3 of the Lee document continues to describe needs associated with a

relational model/database:

> Real-world data are rarely organized according to the relational model,
> and careful consideration needs to be given to alternatives in balancing
> theoretical aspects of the relational model with real-world processing
> requirements and performance of the resulting computerized application.

The fourth full paragraph on page 12 notes that a data manager must be able to safeguard

sensitive data from access by unauthorized personnel. The last paragraph on page 13 again

continues to describe needs associated with a relational model/database:

> The concept of transaction processing should be applied to preserve
> database integrity and consistency, and techniques such as key fields, indexing,
> and query methods must be considered in addressing the important issue of
> system performance.

Thus, reading the Lee document, one would not be motivated to add a central relational

database to the subject matter of the DF documents to achieve the claimed invention because of

the effort required (as described in the Lee document) to develop and maintain a relational

database. In other words, the Lee document teaches that relational database development and

maintenance are complicated processes requiring effort and thought. Thus, the Lee document

teaches away from adding a central relational database to a networked decision making system

because one would need a compelling reason to create and maintain a central relational database

and because the Lee document does not appear to even discuss adding a central database to a

pre-existing networked system.

The August 14, 2003 Office Action appears to indicate that the suggestion or motivation

to combine the Lee and DF documents to achieve the claimed combination is provided by the

Lee Abstract. More specifically, page 12 of the August 14, 2003 Office Action appears to

indicate that the suggestion or motivation to combine the Lee and DF documents to achieve the

claimed combination is 'to provide quick access to data in a manner that reduces anomalies,

minimizes storage requirements, and improves transaction response time (as taught by Lee)"

However, the Lee abstract, when read in full, describes variables that impact the benefits and

costs **of normalization** (versus non-normalization). In other words, the cited section of the Lee abstract is not describing the benefits and costs of adding a central database to a pre-existing networked system but rather the benefits and costs of normalizing a database.

The August 14, 2003 Office Action does not and can not point to a disclosure in the Lee document that provides a suggestion or motivation to make the combination suggested in the Office Action to achieve the invention claimed in claim 1. If the Examiner repeats this rejection, the Applicant respectfully requests that the Examiner specify where in either the DF documents and/or the Lee document such a teaching or motivation is provided.

In sum, for the reasons cited above, currently pending claim 1 is patentably distinct from the DF documents and the Lee document, alone or in combination.

Claims 2 and 3 include similar limitations to claim 1. Therefore, for the reasons cited above, claims 1-3 are patentably distinct over the DF documents and the Lee document, alone or in combination and the rejection of claims 1-3 under 35 USC 103 as obvious over the DF documents in view of the Lee document is traversed.

Independent Claims 4 and 58

Claim 4 provides a process for eliciting, processing, storing, and displaying information concerning a complex business situation. The process includes: *employing a knowledge base providing for structured storage and retrieval of data*; employing at least one of: a) a situation appraisal process; b) a problem analysis process; c) a decision analysis process; and d) a potential side effect analysis process; and *employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status*; wherein each process employs a corresponding set of graphical user interface (GUI) process screens in eliciting data from and presenting data to a user.

The situation appraisal process elicits, stores, retrieves and presents situation data, the situation data including (i) concerns about the situation and respective attributes of the concerns, the attributes of each concern including a relative priority and a process to be used for further analysis, and (ii) actions to be taken to address the concerns. The problem analysis process elicits, stores, retrieves and presents problem data including an object of a problem in the situation and attributes of the object, the attributes including a deviation, possible causes, actions to be taken to confirm a true cause, a confirmed true cause, and actions to be taken to address the confirmed true cause. The decision analysis process elicits, stores, retrieves and presents decision data, the decision data including (i) objectives of a decision regarding the situation and

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respective attributes of the objectives, the attributes of each objective including an indication of relative importance and at least one alternative, (ii) for each alternative a set of risks and respective probabilities and consequences, (iii) a final decision regarding alternatives to be pursued, and (iv) actions to be taken to implement the final decision. The potential side effect analysis process elicits, stores, and presents potential side effect data, the side effect data including potential side effects of an action to be taken to address the situation and respective attributes of the potential side effects, the attributes of each potential side effect including a likely cause, actions to be taken to influence the likelihood of occurrence of the side effect, and actions to be taken in the event of occurrence of the side effect.

Independent claim 58 contains elements/limitations similar to those of claim 4.

Response to rejection of claims 4-111

Contrary to the assertion in the August 14, 2003 Office Action that claim 4 is obvious over the DF documents in view of the Lee document, claim 4 recites element(s)/limitation(s) that are completely absent from the DF documents and the Lee document, alone or in combination.

The DF documents

In particular, as acknowledged by the August 14, 2003 Office Action, the DF documents do not teach "*employing a knowledge base providing for structured storage and retrieval of data*," as claimed in currently pending claim 4. More specifically, pages 11-12 of the August 14, 2003 Office Action state in relevant part:

> Regarding claims 4, 35, and 36, Decision Focus® Software comes in a networked version in which worksheet files can be saved on a network server and shared among various users ("Decision Focus® Software Network Version 1.0 User's Guide": Pages 5, 10, 11). Broadly speaking, a "knowledge base" merely refers to a collection of knowledge, i.e., data; therefore the collection of these worksheet files serves as a "knowledge base." Decision Focus® Software does not expressly teach that these centrally stored worksheet files are linked to one another in a large database (which is what would be suggested by placing the information found in such files in a "knowledge base"). [Emphasis added.]

In addition, the DF documents do not disclose "*employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status* [emphasis added]," as claimed in currently pending claim 4. The action tracker is shown as element 20 in FIG. 1 and is described, among other places, on pages 35 and 36 of the present application.

The August 14, 2003 Office Action discusses claim 4 on pages 5 and 6 and on pages 11 and 12. More specifically, the third paragraph of page 6 of the August 14, 2003 Office Action merely quotes the "action tracker" element(s)/limitation(s) underlined and italicized directly above and then states the following: "('Decision Focus® Software User's Guide (Version 1.0)': Pages 33-35)."

Pages 33-35 of Decision Focus® Software User's Guide (Version 1.0) (hereinafter DF User's Guide) describes 'Problem Prevention." According to page 33 of the DF User's Guide, Problem Prevention is the systematic analysis of a plan to provide assurance that a minimum of problems will occur during implementation. Pages 33-35 of DF User's Guide continue to describe steps for creating a problem prevention worksheet, entering a planning statement, listing the steps necessary for implementing the plan, identifying potential problems and entering preventive and contingent actions.

Pages 33-35 of the DF User's Guide do not disclose "*employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status,*" as claimed in currently pending claim 4. The element(s)/limitation(s) italicized directly above are completely absent from the DF User's Guide. Retrieving actions from the other processes advantageously allows a user to take advantage of work that has been done in the past and/or in other contexts.

The Lee document

Furthermore, the Lee document does not disclose the element(s)/limitation(s) italicized and underlined above, i.e., 1) *employing a knowledge base providing for structured storage and retrieval of data,* and/or 2*) employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status,* as claimed in currently pending claim 4. As noted above, the August 14, 2003 Office Action discusses claim 4 on pages 5 and 6 and on pages 11 and 12.

To the extent that the August 14, 2003 Office Action discusses the Lee document at all, the Office Action appears to discuss the Lee document only briefly on pages 12 and 13. On page 12, the August 14, 2003 Office Action states in relevant part:

> Lee discusses the benefits ("reduced anomalies, storage requirements, and transaction response time") of utilizing normalized databases "in information systems development processes to group data into well-refined structures."

The August 14, 2003 Office Action appears to be quoting a portion of the abstract of the Lee document. The complete abstract indicates that there are costs associated with normalization. More specifically, the complete abstract states the following:

> Proposes a **cost/benefit model** coupled with a decision tree for determining normal forms, which are used in information systems development processes to group data into well-refined structures. The three primary variables that impact the benefits **and costs of normalization** (reduced anomalies, storage requirements, and transaction response times) **are addressed**. [Emphasis added.]

In any event, the Lee abstract in particular and the Lee document in general do not teach: 1) *employing a knowledge base providing for structured storage and retrieval of data*, and/or 2) *employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status*, as claimed in currently pending claim 4.

The DF and Lee documents

The August 14, 2003 Office Action does not and can not point to a teaching in the DF and/or Lee documents of the above-referenced element(s)/limitation(s). If the Examiner repeats this rejection, the Applicant respectfully requests that the Examiner specify where in either the DF documents or the Lee document such element(s)/limitation(s) is/are taught.

Thus, even if one were to combine Lee and the DF documents as suggested one would not arrive at the claimed invention.

Furthermore, there is no motivation or suggestion in the cited documents to make the combination indicated in the Office Action. As noted above, obviousness cannot be established by combining the teachings of the cited documents to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

As noted above, the only statements made in the August 14, 2003 Office Action directly addressing the obviousness rejection of claim 4 are located on pages 5 and 6 and on pages 11 and 12.

In addition, as noted above, *to the extent that the August 14, 2003 Office Action discusses the Lee document at all*, the Office Action appears to discuss the Lee document only briefly on pages 12 and 13. On page 12, *the August 14, 2003 Office Action states* in relevant part:

> Lee discusses the benefits ("reduced anomalies, storage requirements, and transaction response time") of utilizing normalized databases "in information systems development processes to group data into well-refined structures." Therefore, the Examiner asserts that *it would have been obvious* to one of

ordinary skill in the art at the time of Applicant's invention *to centrally store the data from Decision Focus® Software collective worksheet files in a "knowledge base"* (in the stricter sense of a "knowledge base" as a database per se of information), *such as a normalized database, in order to facilitate access to all of the collected worksheet files by various networked users* through keyword searches *in order to provide quick access to data in a manner that reduces anomalies, minimizes storage requirements, and improves transaction response time (as taught by Lee)*. [Emphasis added.]

In contrast to the characterization of the teaching of Lee provided in this quote from the August 14, 2003 Office Action, Lee teaches away from making the suggested combination. As noted above, the Lee document describes design choices that one makes when designing a relational database and describes the efforts that one undertakes to create and maintain a relational database model. For example, the second full paragraph of page 2 of the Lee document states in relevant part:

> [the database administrator] is often responsible for backing up and restoring the database when it becomes corrupted due to equipment failure, power loss, or program errors.

The top of page 3 of the Lee document continues to describe needs associated with a relational model/database:

> Real-world data are rarely organized according to the relational model, and careful consideration needs to be given to alternatives in balancing theoretical aspects of the relational model with real-world processing requirements and performance of the resulting computerized application.

The fourth full paragraph on page 12 notes that a data manager must be able to safeguard sensitive data from access by unauthorized personnel. The last paragraph on page 13 again continues to describe needs associated with a relational model/database:

> The concept of transaction processing should be applied to preserve database integrity and consistency, and techniques such as key fields, indexing, and query methods must be considered in addressing the important issue of system performance.

Thus, reading the Lee document, one would not be motivated to add a relational database to the subject matter of the DF documents to achieve the claimed invention because of the effort required (as described in the Lee document) to develop and maintain a central relational database. In other words, the Lee document teaches that relational database development and maintenance are complicated processes requiring effort and thought. Thus, the Lee document teaches away from adding a central relational database to a pre-existing networked decision

making system because one would need a compelling reason to create and maintain a central relational database and because the Lee document does not appear to even discuss adding a central database to a pre-existing networked system.

The August 14, 2003 Office Action appears to indicate that the suggestion or motivation to combine the Lee and DF documents to achieve the claimed combination is provided by the Lee Abstract. More specifically, page 12 of the August 14, 2003 Office Action appears to indicate that the suggestion or motivation to combine the Lee and DF documents to achieve the claimed combination is 'to provide quick access to data in a manner that reduces anomalies, minimizes storage requirements, and improves transaction response time (as taught by Lee)." However, the Lee abstract, when read in full, describes variables that impact the benefits and costs **of normalization** (versus non-normalization). In other words, the cited section of the Lee abstract is not describing the benefits of adding a central database to a pre-existing networked system but rather the benefits and costs of normalizing a database.

The August 14, 2003 Office Action does not and can not point to a disclosure in the Lee document that provides a suggestion or motivation to make the combination suggested in the Office Action to achieve the invention claimed in claim 1. If the Examiner repeats this rejection, the Applicant respectfully requests that the Examiner specify where in either the DF documents and/or the Lee document such a teaching or motivation is provided.

In sum, for the reasons cited above, currently pending claim 4 is patentably distinct from the DF documents and the Lee document, alone or in combination.

Independent claim 58 is a computer readable medium claim that includes elements/limitations similar to claim 4. Therefore, for the reasons cited above, claim 58 is patentably distinct over the DF documents and the Lee document, alone or in combination. Furthermore, claims 5-57 and 59-111 are dependent on claims 4 and 58, respectively. Therefore, claims 5-57 and claims 59-111 are patentably distinct over the DF documents and the Lee document, alone or in combination, at least for the reasons cited above with respect to claim 4 and the rejection of claims 4-111 under 35 USC 103 as obvious over the DF documents in view of the Lee document is traversed.

Furthermore, the subject matter of the dependent claims, e.g., claims 30 and 46-57, further patentably distinguish over the cited documents. For example, claim 30 recites the following: "A process according to claim 4, wherein the action tracking process further includes eliciting, storing, retrieving, and presenting process data from at least one of the other processes in addition to the associated actions." In rejecting claim 30, page 9 of the August 14, 2003

Office Action merely cites pages 11-32 of the DF User's Guide without further explanation. Applicant's respectfully request, if this rejection is repeated, that the Examiner specify where in the DF User's Guide the subject matter of claim 30 is taught.

Moreover, with respect to a number of claims, e.g., claims 8-16 (pages 13-15 of the August 14, 2003 Office Action) and 43-45 (page 16 of the August 14, 2003 Office Action), the Examiner takes Official Notice that a variety of subject matter is old and well known in a variety of arts. For example, page 14 of the August 14, 2003 Office Action states the following:

> Official Notice is taken that the process of checking to screen and filter data input by a user with the motivation of ensuring the completeness and correctness of the entered data (claim 9) is old and well-known in the art of form filing. Official Notice is also taken that, for the same reasons (i.e., to ensure the completeness and corrections [sic] of entered data), it is old and well-known in the art of form filing to perform the following types of proofreading/completion checking/error correction: check misstated information to detect skipped steps, unsound data, and incomplete analysis (claim 10); check common pitfalls to advise the user of pitfalls that can be encountered as a result of impreciseness in the entered data (claim 11); sharpen to successively refine entered data considered to be critical to proper analysis (claim 12); notify the user upon detection of incomplete or incorrect data (claim 13); notify the user by displaying a message to the user as the user attempts to advance to a succeeding GUI process screen (claim 14); and notify the user by displaying a message to the user immediately upon detection of incomplete or incorrect data (claim 15).

The Applicants assert that the subject matter of claims 8-16 and 43-45 is not old and well-known in the relevant art(s). In the event that the Examiner repeats the 35 USC 103 rejection of claims 8-16 and 43-45 included in the August 14, 2003 Office Action, per MPEP 2144.03, Applicants respectfully request that the Examiner provide evidence, e.g., documentary evidence or an affidavit (if the Examiner is relying on personal knowledge), to support the various takings of Official Notice on pages 13-16.
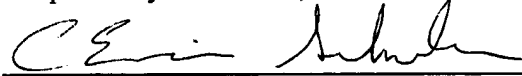
The Applicant believes that this application is in condition for allowance and respectfully request entry of this amendment and allowance of the application. This amendment does not introduce new matter.

If there are any questions regarding this amendment and/or these remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

The Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 24200-002 CON.

Respectfully submitted,

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